



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/551,173

09/29/2005

Ken'ichi Fujii

00862.023538.

4237

5514

7590

03/25/2009

FITZPATRICK CELLA HARPER & SCINTO

30 ROCKEFELLER PLAZA

NEW YORK, NY 10112

EXAMINER

NEURAUTER, GEORGE C

ART UNIT

PAPER NUMBER

2443

MAIL DATE

DELIVERY MODE

03/25/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/551,173

## Applicant(s)

FUJII ET AL.

## Examiner

George C. Neurauter, Jr.

## Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-4 and 6-16 are currently presented and have been examined.

#### ***Response to Arguments***

Applicant's arguments filed 7 January 2009 have been fully considered but they are not persuasive.

The Applicant argues that, regarding claims 1, 2, and 13, Serceki does not teach or suggest transmitting a search request to a device identified in response to a detected beacon, therefore, Serceki does not teach or suggest the claimed "first transmission unit adapted to transmit a search request signal to a wireless device that is present on a network identified by network identification information included in a beacon detected by said detection unit so as to search for a wireless communication device having a predetermined data processing function," a "determination unit adapted to determine a wireless communication device having the predetermined data processing function on the basis of a response signal that the determined wireless communication device has transmitted in response to the search request signal transmitted by said first transmission unit," and a "control unit adapted to, when a user selects the information displayed by said display unit while said detection unit detects the beacon, terminate the detection process of said detection unit and execute connection processing with a wireless communication device specified by the selected information".

The Examiner respectfully disagrees.

Serceki discloses that, upon discovering a device identified in a detected beacon, that the wireless communication device then stops the detection process and proceeds

to "associate" with the device identified in the beacon after a user determination to connect to the device identified in the beacon (see at least paragraph 0009, specifically "When a WSTA 16 is attempting to associate with an AP, the WSTA employs any one of a plurality of techniques for determining which AP to access. For example, the WSTA may scan through the 14 channels until it finds an AP and associates with the first AP it finds." and paragraph 0011, specifically "The problems noted above are solved in large part by a wireless LAN monitoring application that scans through all possible channels, displays information indicative of the activity level on each channel, and permits a user to select a channel having an access point with which to associate.") "Association" as known in the art and as described in Serceki uses signals including "search requests" and "response signals" as claimed to negotiate a connection between the wireless communication device and the device identified in response to a detected beacon in an "SSID" as described in Serceki. For example, the "search request" as claimed may be a request to connect to the "SSID"-identified device and the "response signal" can be in the affirmative by information that can be used to connect to the "SSID"-identified device. Therefore, Serceki does disclose these limitations.

The Applicant argues that "Zero" does not teach or suggest an "instruction unit adapted to instruct one of a history search mode that communicates with a desired partner wireless communication device based on the information stored in said storage unit, and a new search mode that searches for a new partner wireless communication device via a wireless communication, and communicates with the new partner wireless communication device," a "search unit adapted to compare network identification

information included in the detected beacon with the network identification information stored in said storage unit, make said detection unit detect another beacon, if there is a match in the compared network identification information, and search for a partner wireless communication device to communicate with based on new network identification information, if the new network identification information is detected," and a "first display unit adapted to selectably display device identification information of a wireless communication unit found by said search unit" as recited in claims 10 and 14. The Applicant contends that "As best understood by Applicants, the Wireless Zero Configuration Service does not perform the functions of the claimed search unit and first display unit, because the "Available networks" portion includes device identification information of a wireless communication device that has previously connected to computer. That is, there is no display area that lists only information regarding devices to which the computer has not connected previously."

The Examiner respectfully disagrees in view of the broadest reasonable interpretation of the claimed invention. The claim only requires that the "instruction unit" is adapted to "instruct one of a history search mode...and a new search mode..." The Applicant admits that "Zero" does disclose a "history search mode" and "Zero" does teach these limitations. Therefore, the claim may be interpreted that only the "history search mode" has weight within the claim and all limitations referring to the "new search mode" may be interpreted as not having weight. Therefore, "Zero" does teach the claimed invention.

Regarding claims 11, 12, and 15, The Applicant argues that Serceki does not teach or suggest a wireless communication device that includes a "discrimination unit adapted to discriminate a type of device capable of executing a processing designated by an operator," a "determination unit adapted to, when receiving a beacon transmitted by a device on a wireless network, determine whether device identification information corresponding to the type discriminated by said discrimination unit is included in the received beacon," and a "display unit adapted to, if said determination unit determines that the device identification information corresponding to the type discriminated by said discrimination unit is included in the received beacon, selectably display information associated with the device that transmitted the beacon". The Applicant contends that "As best understood by Applicants, Serceki is silent regarding transmitting a beacon including device identification information indicating a device function."

The Examiner respectfully disagrees.

As also described above regarding claims 1, 2, and 13, Serceki disclosed the use of an "SSID" that is transmitted within a beacon that is detected by the wireless communications device. Within the context of the claimed invention and disclosures of Serceki, this "SSID" indicates to the wireless communication device that the "SSID" device that sends the beacon offers user-desired services such as Internet service to the wireless device. Therefore, Serceki does teach these limitations.

Therefore, Serceki and "Zero" teach or suggest the currently amended claims and the claims are not in condition for allowance.

***Claim Objections***

Claim 10 is objected to because of the following informalities:

Claim 10 recites "...execute a wireless communication establishment process with wireless communication unit...". This limitation should read "...execute a wireless communication establishment process with the wireless communication unit..."

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-9, 11-13, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication 20040102192 to Serceki.

Regarding claim 1, Serceki disclosed a wireless communication system having first and second wireless communication devices, wherein said first wireless communication device ("wireless station" including a "wireless monitoring application") comprises:

a detection unit adapted to detect a plurality of beacons at a plurality of frequencies; a first transmission unit adapted to transmit a search request signal to a wireless device a first transmission unit adapted to transmit a search request signal (attempt to "associate") to a wireless device that is present on a network identified by

network identification information included in a beacon ("SSID") detected by said detection unit so as to search for a wireless communication device having a predetermined data processing function (providing Internet services);

a determination unit adapted to determine a wireless communication device ("access point") having the predetermined data processing function on the basis of a response signal (response to the attempt to "associate") that the determined wireless communication device has transmitted in response to the search request signal transmitted by said first transmission unit;

a display unit adapted to selectably display information associated with the wireless communication device determined by said determination unit so as to determine a wireless communication partner; and

a control unit adapted to, when a user selects the information displayed by said display unit while said detection unit detects the beacon, terminate the detection process of said detection unit and execute connection processing with a wireless communication device specified by the selected information, and

said second wireless communication device (the "access point") comprises:

a second transmission unit adapted to transmit a signal including self identification information as the response signal (response to attempt to "associate" providing information on how to connect to the device), when search request information is detected in a wireless reception waiting state at a predetermined frequency. (see at least paragraphs 0011 and 0012)



Claims 2 and 13 are also rejected since these claims recite in whole or in part substantially the same limitations as recited in claim 1.

Regarding claim 3, Serceki disclosed the device according to claim 2, wherein said transmission unit connects the network identified by the network identification information included in the beacon detected by said detection unit and transmits the search request information to the network, and said determination unit stores in a memory identification information of a wireless communication unit on a partner side included in a response to the search request information upon reception of the response, and said display unit selectably displays the identification information stored in the memory. (see at least paragraphs 0011 and 0012)

Regarding claim 6, Serceki disclosed the device according to claim 2, wherein when no signal is received in response to the search request signal within a predetermined period of time, an error display is made. (see at least paragraphs 0011 and 0012) (if no partner wireless communication device is found, the user would inherently discover over a user selected period of time that no device is available and that the display's lack of showing an available device is indicative of such an error that no device is available)

Regarding claim 7, Serceki disclosed the device according to claim 2, further comprising: determination means for determining if the beacon detected by said detection means is a beacon in an adhoc communication mode or a beacon in an infrastructure communication mode, and when said determination means determines that the detected beacon is the beacon in the adhoc communication mode, said search

means transmits search request information toward a wireless communication processing device as a generation source of the detected beacon, and when said determination means determines that the detected beacon is the beacon in the infrastructure mode, said search means transmits search request information of a wireless communication processing device toward an access point. (see at least paragraphs 0007, 0008, and 0011)

Regarding claim 8, Serceki disclosed the device according to claim 2, further comprising registration means for registering, in a memory, information associated with connection to the partner, wireless communication device, to which a wireless communication has been established. (see at least paragraph 0034) (the wireless station uses the information in a beacon frame to associate with the access point and stores the information for the connection)

Regarding claim 9, Serceki disclosed the device according to claim 8, further comprising a mode for executing a process for establishing a wireless communication on the basis of the information registered by said registration means. (see at least paragraph 0034)

Regarding claim 11, Serceki disclosed a wireless communication system having first and second wireless communication devices, wherein said first wireless communication device comprises: a discrimination unit adapted to discriminate a type of device capable of executing a processing designated by an operator; a determination unit adapted to, when receiving a beacon transmitted by a device on a wireless network, determine whether device identification information corresponding to the type

discriminated by said discrimination unit is included in the received beacon; and a display unit adapted to, if said determination unit determines that the device identification information corresponding to the type discriminated by said discrimination unit is included in the received beacon, selectably display information associated with the device that transmitted the beacon, and said second wireless communication device comprises: an informing adapted to include device identification information indicating a function into a beacon and transmitting the beacon to the wireless network, and when information of said second wireless communication device among information displayed by said display unit is selected, a process for establishing a communication between said first and second wireless communication devices is executed. (see at least paragraphs 0011 and 0012)

Claims 12 and 15 are also rejected since claims 12 and 15 recite substantially the same limitations as recited in claim 11.

Regarding claim 16, Serceki disclosed the device according to claim 2, wherein said predetermined data processing function includes at least one of a data printing function and a data saving function. (the "access point" provides Internet services, that may include saving of data at a remote location or at the access point itself for saving the connection information of the wireless communication device connecting to the "access point")

Claims 10 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by "The Windows XP Wireless Zero Configuration Service" ("Zero").

Regarding claim 10, "Zero" disclosed a wireless communication device (computer executing the Windows XP operating system including the Windows XP Wireless Zero Configuration Service) comprising:

A storage unit (contained on the computer) adapted to store device identification information and network identification information of a partner to which the wireless communication device has been connected previously ("preferred network"; see also "Preferred Networks" on page 2); an instruction unit adapted to instruct one of a history search mode that communicates with a desired partner wireless communication device based on the information stored in said storage unit, and a new search mode that searches for a new partner wireless communication device via a wireless communication, and communicates with the new partner wireless communication device; a beacon detection unit adapted to, when said instruction unit instructs the new search mode, detect a beacon; a search unit adapted to compare network identification information included in the detected beacon with the network identification information stored in said storage unit, make said detection unit detect another beacon if there is a match in the compared network identification information, and search for a partner wireless communication device to communicate with based on new network identification information if the new network identification information is detected; a first display unit adapted to selectably display device identification information of a wireless communication unit found by said search unit; a second display unit adapted to, when said instruction unit instructs the history search mode, selectably display the device identification information of a wireless communications unit stored in said storage unit;

and a wireless communication establishment process unit adapted to, when device identification information displayed by one of said first and second display unit is selected, execute a wireless communication establishment process with wireless communication unit specified by the selected device identification information. (see "preferred networks" on page 3 and "How the WZC service works on pages 4 and 5) (see also plural displayed windows on pages 2 and 3)

Claim 14 is also rejected since claim 14 recites substantially the same limitations as recited in claim 10.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serceki in view of US Patent 6,529,522 to Ito et al.

Regarding claim 4, Serceki disclosed the device according to claim 2.

Serceki did not expressly disclose wherein each of the wireless communication device and the partner wireless communication device comprises one of an image sensing device, a device for executing a print process of a sensed image, and a storage device for executing a storage process of a sensed image, however, Ito did disclose these limitations (see at least column 8, lines 19-62)

It would have been obvious to one of ordinary skill in the art the time the invention was made to combine the teachings of these references since both references disclose analogous subject matter regarding wireless communication devices and their connections with partner wireless communication devices and one of ordinary skill would have found that the substitution of a wireless communication device and a partner communication device with the image sensing device and a device for executing a print process of a sensed image would not introduce any unforeseen changes in the operation of the device of Serceki regarding wireless communications and would have reasonably predicted a successful combination of the wireless functionality of Serceki

and the image sensing device and the device for executing a print process of a sensed image described in Ito.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571)272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C Neurauter, Jr./  
Primary Examiner, Art Unit 2443